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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/752,465

01/06/2004

Charles Widman

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06/10/2004

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EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/752,465

**Applicant(s)**

WIDMAN ET AL.

**Examiner**

Dmitry Suhol

**Art Unit**

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/23/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 4, 7, 9, 11-14, there is no antecedent basis for "the document".

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson '529 in view of Woods '901, Chua '299 and Covell '412. Dickson discloses a educational bookmark that can be used with erasable markings containing most of the elements of the claims including a reusable sheet having two sides and a top edge (sheet 10, col. 2, lines 63-67) as required by claims 1, 4, 11 and 12, a clamping device

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(clip 26) as required by claims 1, 4, 11 and 12, an erasable writing instrument (10) as required by claims 1, 4, 11 and 12. A top edge having an adhesive coating, as required by claims 2, 5, 11 and 12, is described in col. 4, lines 2-5. The use of transparent vinyl and a marking pen containing water soluble ink, as required by claims 4 and 12, is described in col. 3, lines 16-18 and lines 22-26.

Although Dickson discloses most of the elements of the claims, as stated above, and further including a teaching that his device can be manufactured from a variety of materials including a polyester material (col. 3, lines 31-41), the reference fails to explicitly teach a sheet being transparent as required by claims 1, 4, 11 and 12, and composed of a non-top coated polyester film as required by claims 1, 11, a clamping device capable of securing the sheet to a document to be marked as required by claim 1, 4, 11 and 12, an erasable writing instrument being a dry erase marking pen as required by claims 1, 11 and an eraser as required by claims 3, 4, 11. However, Chua discloses that it is known to manufacture erasable bookmarks from a transparent material (including polyester) in page 1, paragraph [0010] and [0012]. While Woods teaches that it is known to utilize a non-top coated material as an erasable surface (col. 2, line 42), which can be packaged together with a dry-erase marker (16) and eraser (20). Covell discloses a bookmark and holder, like that of Dickson, which further teaches structure which allows it to be capable of being clamped to a document/book (figures 1-2 and lines 85-90). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the applicants invention, to manufacture the device of Dickson from a transparent non-top coated polyester material packaged with a dry

erase marking pen and eraser for the purpose of providing a bookmark which limits the amount of obstructed text while at the same time providing a durable, simple, easy to use surface which does not wipe off readily with ordinary handling but will wipe off easily with the eraser. It would have further been obvious to utilize the structure of Covell in the clip of Dickson for the purpose of providing a bookmark that can be clipped to a book/document it is being used with, especially since Dickson clearly states that a variety of configurations of the clip portion of his device is envisioned with his invention (col. 4, lines 8-9).

Claims 7-8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chua '299 in view of Woods '901 and Sweet '279. Chua discloses an erasable transparent bookmark sheet containing most of the element of the claims including, a reusable transparent sheet having two sides and top which is comprised of polyester and the use of a erasable markers (figures 1-2 and page 1, paragraph [0010] and [0012]) as required by claims 7 and 13.

Chua lacks the explicit teaching of a dry erase marker as required by claims 7, 13, an adhesive layer as required by claims 7, 11 and an eraser as required by claims 8, 13. However, Woods teaches that it is known to utilize a non-top coated material as an erasable surface (col. 2, line 42), which can be packaged together with a dry-erase marker (16) and eraser (20). Sweet teaches that it is known to provide an adhesive layer (22) on the top portion of a bookmark. Therefore it would have been obvious to manufacture the device of Chua from a non-top coated polyester packaged with a dry-

erase marker and eraser for the purpose of time providing a durable, simple, easy to use surface which does not wipe off readily with ordinary handling but will wipe off easily with the eraser. It would have been further obvious to provide an adhesive surface (in place of the clip) on the top portion of the Chua device for the purpose of attachment to a book/document especially since the examiner takes official notice that an adhesive layer is a well known equivalent to a clip in the removable attachment arts.

Claims 9-10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chua '299 in view of Dickson '529, Woods '901 and Sweet '279. Chua discloses an erasable transparent bookmark sheet containing most of the element of the claims including, a reusable transparent sheet having two sides and top and the use of a erasable markers (figures 1-2 and page 1, paragraph [0010] and [0012]) as required by claims 9 and 14.

Chua lacks the explicit teaching of a marking pen containing water soluble ink as required by claims 9, 14, an adhesive layer as required by claims 9, 14 and an eraser as required by claims 10, 14. However, Dickson discloses a device like that of Chua which teaches that it is known to utilize a clear vinyl as a writing surface (col. 3, lines 16-19) along with a marking pen containing water soluble ink (col. 3, lines 22-26). Woods teaches that it is known to package an erasable surface (col. 2, line 42) with an eraser (20). Sweet teaches that it is known to provide an adhesive layer (22) on the top portion of a bookmark. Therefore it would have been obvious to manufacture the device of Chua from transparent vinyl packaged with a marking pen containing water soluble ink

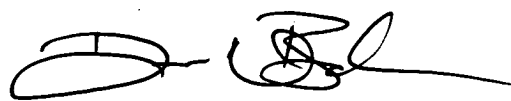
and eraser for the purpose of providing a durable, simple, easy to use surface that has a smooth glossy finish and is easily erasable. It would have been further obvious to provide an adhesive surface (in place of the clip) on the top portion of the Chua device for the purpose of attachment to a book/document especially since the examiner takes official notice that an adhesive layer is a well known equivalent to a clip in the removable attachment arts.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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